

BEST AVAILABLE COPY

Application No. 10/772,746

REMARKS

After entry of this response, claims 1-24 remain pending in the present application. In response to the objection to the Abstract issued in the Office Action dated October 31, 2002, Applicants have responded by amending the Abstract to include the suggestion of the Examiner by deleting the phrase "The present invention relates to a" and replacing it with the word "A".

Additionally, the Examiner has rejected claims 13-15 and 19-24 under 35 U.S.C. §103(a) as being unpatentable over Willemssen (U.S. Patent No. 5,832,687). In response, Applicants respectfully traverses the above-mentioned rejection under 35 U.S.C. §103(a) and requests reconsideration by the Examiner in view of the following remarks.

The Examiner bears the initial burden in establishing a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. In re Piasecki, 745 F.2d 1468, 223 USPQ 758 (Fed. Cir. 1985); In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.

In order to establish prima facie obviousness of a claimed invention, the Examiner must show that all the claim limitations are taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). If an independent claim is nonobvious, then any claim depending on that claim is also nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The present invention discloses a deterioration resistant retaining wall planter block comprising a top panel, bottom panel and wall assembly adjoined to form a chamber. The top panel, bottom panel and wall assembly are comprised of a deterioration resistant composite or polymeric material and include one or more apertures, which allow vegetation to grow from the apertures to the exterior of the planter block. See page 4, lines 16-18. Additionally, independent claim 13 claims that the retaining wall planter block includes one or more fill

materials suitable for the growth of vegetation administered to the chamber and vegetation seeds included in or applied to the fill material. The reference cited by the Examiner discloses a children's block that does not include the limitations of the planter block claimed in the present patent application. For example, as mentioned by the Examiner, Willemssen fails to disclose the vegetation seeds and plurality of apertures identified in the claims of the present invention. Furthermore, Willemssen provides no motivation to lead a person of ordinary skill in the art to alter the block taught in Willemssen to include seeds and an aperture. Moreover, Willemssen teaches away from such limitations. For example, Willemssen only teaches a manually sealable orifice that is intended to seal the block and nowhere discloses or suggests the inclusion of seeds that are intended to grow to the block exterior from the plurality of apertures positioned on the retaining wall block. Because the reference cited by the Examiner does not disclose all of the claim limitations of this independent claim and no motivation has been shown to include such limitations, a prima facie case of obviousness has not been established for independent claim 13 and also dependent claims 14-15 and 19-24 of the present application. Therefore, the Applicants respectfully request further examination and reconsideration of this application in view of the present remarks.

The Examiner has also rejected claims 1-7 and 9-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,571,529 and U.S. Patent Application Nos. 10/331,407. The Applicants respectfully traverse the rejection and disagree with the Examiner's assertion that "it would have been obvious to one having ordinary skill in the art of retaining walls...to modify the device shown (in the '529 Patent and '407 Application) such that it would include a plurality of apertures" and "include fill material and vegetation seeds". These references fail to disclose all of the limitations claimed in claims 1-7 and 9-23. For example, the '529 Patent and '407 Application fail to disclose the claim limitations of "vegetation seeds" and "plurality of apertures" as identified in the claims of the present application. Furthermore, these references show no motivation to lead a person of ordinary skill in the art to alter the block taught in the '529 Patent and '407 application to include

Application No. 10/772,746

seeds and a plurality of apertures. Because the reference cited by the Examiner does not disclose all of the claim limitations of the rejected claims and fails to identify a motivation to include such missing limitations, a prima facie case of obviousness-type double patenting has not been established for claims 1-7 and 9-23. Therefore, the Applicants respectfully request further examination and reconsideration of this application in view of the present remarks.

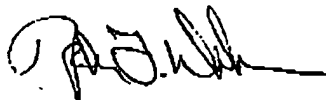
The Examiner has also rejected claims 1-4 and 13-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,695,544. The Applicants respectfully traverse the rejection and disagree with the Examiners assertion that "it would have been obvious to one having ordinary skill in the art of retaining walls...to modify the device shown by U.S. Patent No. '544 such that it would include a plurality of apertures...(and) fill material and vegetation seeds." However, to advance prosecution of this Application and to obtain allowance on allowable claims at the earliest possible date, the Applicants will file a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection based on a nonstatutory double patenting ground upon receiving notice of the allowance of the claims. It is noted that no admission may be inferred by this response or any terminal disclaimer filed in the present application and the Applicants reserve the right to pursue similar claims in the future.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Application No. 10/772,746

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



John F. Dolan
Registration No. 45,382

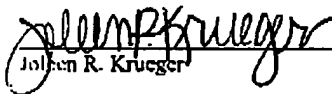
Customer No. 22859
Fredrikson & Byron, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402-1425 USA
Telephone: (612) 492-7000
Facsimile: (612) 492-7077

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306 on the date shown below.

January 3, 2005
Date


John R. Krueger

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☒ FADED TEXT OR DRAWING
- ☒ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.